

REMARKS

This is in full and timely response to the above-identified Office Action. The above listing of the claims replaces all prior versions, and listings, of claims in the application. Reexamination and reconsideration in light of the following remarks are respectfully requested.

Claim Objections

In this response, claims 14 and 23 are amended to rectify the minor informalities noted in paragraphs ##3 and 4 of this Office Action. Inasmuch as these amendments merely cure typographical errors and neither raise any new issues nor introduce any new matter, it is requested that these amendments be entered and, for reasons set forth below, the application be passed to issue.

IDS

An IDS was filed on 09/22/2004 and accompanied the previous response. It is requested that this filing be acknowledged and an initialed copy of SB/08 be returned to the Applicant in any subsequent action taken in connection with this application.

Rejections under 35 U.S.C. § 102

The rejection of claims 1-4, 9-17 and 19-24 under 35 U.S.C. § 102(e) as being anticipated by Hull et al. (US 2005/0024682) is respectfully traversed.

35 USC § 102(e) requires the claimed invention to have been described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Hull et al. (US 2005/0024682) was filed on 03/30/2004 which is about three years after the instant application (03/19/2001). While Hull et al. (US 2005/0024682) claims to be a CIP of two applications (USN 09/728,453 filed 10/30/2000, and USN 09/728,560 filed on 10/30/2000) it is clear from a review of these applications that they do not disclose a "printer" per se, let alone a printer which can perform the operations alluded to in Hull et al. (US 2005/0024682). Therefore, all of the disclosure in Hull et al. (US 2005/0024682) pertaining to the printer functions was new subject matter added after the filing date of the instant application. Copies of the two applications (USN 09/728,453 filed 10/30/2000, and USN 09/728,560 filed on 10/30/2000) are enclosed – see Appendix.

Therefore, the earliest date which the Hull et al. (US 2005/0024682) reference may be relied upon for subject matter relating to printers, is after the filing date of the instant application. Hull et al. (US 2005/0024682) is therefore removed as a reference under § 102(e) against the claimed subject matter.

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IV. PARENT'S FILING DATE WHEN REFERENCE IS A CONTINUATION-IN-PART OF THE PARENT

~~The filing date of U.S. parent application can only be used~~
as the 35 U.S.C. 102(e) date if it supports the claims of the
issued child

In order to carry back the 35 U.S.C. 102(e) critical date of the U.S. patent reference to the filing date of a parent application, the parent application must (A) have a right of priority to the earlier date under 35 U.S.C. 120 and (B) support the invention claimed as required by 35 U.S.C. 112, first paragraph. "For if a patent could not theoretically have issued the day the application was filed, it is not entitled to be used against another as 'secret prior art' " under 35 U.S.C. 102(e).

See *In re Wertheim*, 646 F.2d 527, 537, 209 USPQ 554, 564 (CCPA 1981) and *Ex parte Gilderdale*, 1990 Pat. App. LEXIS 25 (Bd. Pat. App. & Inter. Appeal no. 89-0352)

It is again submitted that Hull et al. (US 2005/0024682) is not available as a reference under § 102(e) against the claimed subject matter.

Rejections under 35 U.S.C. § 103

The rejection of claims 5-8 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Hull et al. in view of Marx, is respectfully traversed.

This rejection is untenable for at least the same reason that Hull et al. is not available as a reference against the claimed subject matter.

Conclusion

It is submitted that the claims as they stand before the PTO are allowable for at least the reasons advanced above. Favorable reconsideration and allowance of this application is courteously solicited.

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